

REMARKS/ARGUMENTS

Claims 1-17 stand rejected in the outstanding Official Action. Claims 10 and 11 have been cancelled without prejudice and claims 1-9 and 12-17 amended. Therefore, claims 1-9 and 12-17 remain in this application.

The Examiner's acknowledgment of Applicants' claim for priority and receipt of the certified copy of the priority document is very much appreciated. Additionally, the Examiner's consideration of the previously submitted Information Disclosure Statement is appreciated.

In sections 3 and 4 of the Official Action, Applicants have been requested to review the specification and provide additional information to the Patent Office. Applicants indicate that there are no co-pending applications which are mentioned in the description of the present application.

The Abstract is objected to because of the presence of numerals in the Abstract. While the numerals are clearly permitted under the PTO rules and the Code of Federal Regulations and clearly relate to features shown in the drawings, Applicants have amended the Abstract to cancel the numeral references. Applicants have also cancelled the reference to Figure 6, thereby obviating all objections to the Abstract.

In section 6 of the Official Action, claim 17 is objected to allegedly under 37 CFR 1.75(c) as failing to further limit the subject matter of a previous claim. Claim 17 recites a computer program product and in accepted "shorthand" fashion has recited that this product performs the method of claim 16.

The Examiner's attention is directed to the case of *Ex parte Porter*, 25 USPQ2d 1144, 1147 (BOPAI 1992) which confirms that the Board of Appeals regards "a claim that incorporates by reference all of the subject matter of another claim, that is, the claim is not broader in any respect, to be in compliance with the fourth paragraph of 35 USC §112." In the *Ex parte Porter* case, a method claim depended from an apparatus claim, and this was specifically approved as a "short-hand format to avoid rewriting the particulars" of the apparatus claim. Here, a product claim, rather than reciting all of the method steps in the computer program, a reference is merely made to method claim 16. Again, clearly a shorthand form of claim drafting which has been considered and accepted by the Board of Appeals.

Applicants have amended claim 17 to meet recent Patent Office guidelines regarding the manner in which computer programs may be claimed, but it is clear that claim 17 incorporates the subject matter of claim 16 and therefore is narrower than claim 16 by itself. For example, claim 16 is not limited to a computer program product and claim 17 by reciting such a product is clearly more limited than original claim 16. Accordingly, reconsideration of any further objection to claim 17 is respectfully requested.

Claims 1-16 are objected to with respect to various alleged informalities set out on pages 3 and 4 of the outstanding Official Action. Most of those informalities have been corrected as suggested by the Examiner, with one exception.

Subsection 8a, remaining claims 1-9 and 12-15 have been amended to read “An apparatus” as suggested by the Examiner. In section 8b, the dependency of claim 14 has been corrected to depend from claim 13 which provides clear antecedent basis, again as suggested by the Examiner. In subsection 8c, Applicants have corrected claims 1 and 16 to recite that the changing is between “said plurality of mapping states” as suggested by the Examiner.

In view of the above amendments, the objections set out in subsections 8a-8c are believed mooted and any further objection or rejection thereon is respectfully traversed.

What objection the Examiner is making in subsection 8d is not understood. Firstly, it is noted that the Preliminary Amendment filed June 25, 2001, concurrent with the filing of the present application, eliminated all multiple dependencies in the claims and therefore no multiple dependency exists. While the Examiner’s statements regarding claim dependency are generally the preferred form, there is no requirement that a dependent claim depend from the first claim in an application or some intermediate claim in that application.

Applicants’ original dependency of claim 14 on claim 5 is clearly proper and violates no portion of the Manual of Patent Examining Procedure (MPEP), let alone §608.01(n) cited by the Examiner in the Official Action. Should the Examiner have a specific rule or statute in mind regarding claim dependency, he is respectfully requested to identify that portion of the rule or statute. However, as noted above, claim 14 has been amended to depend from claim 13, thereby proper antecedent basis for the language of

claim 14. However, claim 14 was and remains a properly dependent claim. Accordingly, clarification of the basis for any remaining objection under section 8d of the Official Action is respectfully requested.

Claim 3 stands rejected under 35 USC §112 (second paragraph) as being indefinite. The Examiner indicates that it is unclear whether "match signals" refers to a separate group of signals or some other interrelationship. Applicants' review of claim 3 indicates that it is a reference to control signals "that control operation of said processor core and match control signals produced on decoding instructions of said first instruction set." Applicants' claim merely recited two attributes of the control signals, i.e., (1) "control operation of said processor core" and (2) "match control signals produced on decoding instructions of said first instruction set." Therefore, the original claim 3 language is entirely accurate. However, to clarify the language, Applicants have amended claim 3 as suggested by the Examiner with the addition of "said control signals match control signals produced on decoding instructions of said first instruction set" thereby obviating any further objection.

Claims 1-17 stand rejected under 35 USC §102 as anticipated by Patel (U.S. Patent 6,332,215). The Court of Appeals for the Federal Circuit has noted in the case of *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984) that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Applicants' previously written claims 10 and 11 have been cancelled without prejudice and the subject matter thereof incorporated into independent claims 1 and 16. Therefore, the subject matter of claims 10 and 11 must be anticipated or rendered obvious by Patel in order to support a rejection of amended independent claims 1 and 16 and claims dependent thereon.

The Examiner addresses former claims 10 and 11 in paragraphs 23 and 24 on page 8 of the Official Action. The Examiner contends that column 5, lines 30-60 of Patel discloses the subject matter of claims 10 and 11 and that look-up table 78 in Figure 4 of Patel is the counterpart of an instruction template in accordance with Applicants' claims. Applicants agree that the cited passage of Patel discloses that byte codes are converted into native instructions by a state machine using a look-up table. Applicants also agree that Patel appears to disclose that counters are maintained to keep count of how many entries have been placed on the operand stack, as well as to keep track of the top of the operand stack.

However, there appears to be no disclosure in the Patel reference suggesting that an instruction template which is associated with an instruction from the second (non-native) instruction set has an instruction set comprising "one or more instructions from said first instruction set" (the native instruction set) wherein "register operands are mapped to said stack operands in dependence upon a currently adopted mapping state of said instruction translator." As will readily be apparent to one of ordinary skill in the art, such instruction templates provide an advantageous degree of flexibility in the nature of

the mapping that may be achieved between instructions of the second instruction set and typically several instructions of the first instruction set. Thus, claim 1 as amended to include the limitations of claims 10 and 11 is now clearly patentable over the Patel reference.

Should the Examiner believe that Patel actually contains a disclosure of the subject matter of claims 10 and 11, he is required to point to precisely that portion of the text which contains the limitations added to Applicants' independent claim 1. Applicants' independent method claim 16 has similarly been amended. As such, neither independent claims 1 nor 16 can be anticipated or rendered obvious in view of the Patel teaching or rather in view of its failure to teach the claimed subject matter.

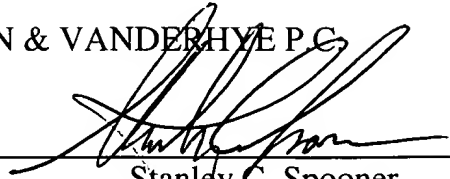
Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-9 and 12-17 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicants' undersigned representative.

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Respectfully submitted,

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